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09/855,242	05/15/2001	Ryohei Sato	14632	8991

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GARDEN CITY, NY 11530

EXAMINER

QUINONES, ISMAEL C

ART UNIT PAPER NUMBER

2686

DATE MAILED: 06/21/2004

8

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

**Application No.**

09/855,242

**Applicant(s)**

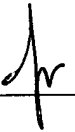
SATO, RYOHEI

**Examiner**

Ismael Quiñones

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2004.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-19 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This Action is in response to Applicant's amendment filed on April 5<sup>th</sup>, 2004.

**Claims 1-19** are now pending in the present application. **This Action is made FINAL.**

### *Information Disclosure Statement*

2. The information disclosure statement (IDS) submitted on May 15, 2001 has being considered by the examiner and made of record in the application file.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. **Claims 1, 3, 7, 9, and 19** are rejected under 35 U.S.C. 102(e) as being anticipated by Shi (U.S. PG- Pub. No. 2002/0102977).

Regarding **claim 1**, Shi discloses a cellular telephone apparatus which has a cellular telephone set capable of originating a plurality of calls to a base station and communicating with an accessory (An accessory such as a base station) through sub-communication means (A mobile such as a cellular telephone apparatus having a cellular telephone set that has two or more links with different base stations involved in a handoff process, wherein one of the links is an

alternative link such as a sub-communication means; *Page 1, Paragraph 7*), and said accessory capable of communicating with said cellular telephone set through said sub-communication means (A communication such as a physical connection/channel set between a mobile and a base station; *Page 1, Paragraph 5; Page 2, Paragraph 17*), and can execute a communication function other than a voice communication function by said cellular telephone through said sub-communication means (An apparatus adapted to a PCS communications system that bundle voice communications, numeric and text messaging, voice-mail and various other features into one device, and are carried over cellular links; *Page 2, Paragraph 16*), comprising: monitoring means for monitoring channel quality of sub-communication between said cellular telephone set and said accessory during communication with a remote cellular telephone set by using said accessory (Monitoring such as evaluating the signal quality for the communication between a mobile and an base station/accessory; *Page 2, Paragraph 17*); and control means for, when said monitoring means determines that the channel quality of the sub-communication has deteriorated to not more than a predetermined level, causing said cellular telephone set to start originating a call to the remote cellular telephone set (A dynamic threshold corresponding to the signal quality from the present communication and handing off the communication to another base station wherein said base station establishes a coverage area/cell and the mobile unit starts to originates a call to the remote cellular telephone set through the handed base station; *Page 2, Paragraph 18; Page 4, Paragraph 43*).

Regarding **claim 3**, and as applied to claim 1, Shi discloses the aforementioned apparatus wherein said accessory comprises a musical unit (A mobile unit or cellphone apparatus that can process sound data such as voice that could be applied for musical means; *Page 1, Paragraph 13*).

Regarding **claim 7**, and as applied to claim 1, Shi discloses the aforementioned apparatus, wherein said sub-communication means is radio communication (A radio communication such as a radio link between the mobile unit and the base station; *Page 1, Paragraph 12*).

Regarding **claim 9**, and as applied to claim 3, Shi discloses the aforementioned apparatus, wherein said sub-communication means is radio communication (A radio communication such as a radio link between the mobile unit and the base station; *Page 1, Paragraph 12*).

Regarding **claim 19**, Shi discloses a communication method for a cellular telephone apparatus including a cellular telephone set capable of originating a call in addition to a call for voice communication (An apparatus adapted to a PCS communications system that bundle voice communications, numeric and text messaging, voice-mail and various other features into one device, and are carried over cellular links; *Page 2, Paragraph 16*), and an accessory capable of communicating with the cellular telephone set by using a radio channel for sub-communication (A radio channel such as radio link between the mobile unit and the base station; *Page 1, Paragraph 12*), wherein even if channel quality of a radio channel for the sub-communication has deteriorated to not more than a predetermined level, when the cellular telephone set can perform voice

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communication with a remote cellular telephone set, the cellular telephone set is allowed to perform voice communication with the remote cellular telephone set (An evaluating process wherein the link quality is improved by assigning the mobile unit to another base station that can handle the communications when said link quality starts to degrade, therefore allowing the continuation of the call; *Page 4, Paragraph 43; Page 1, Paragraph 2 and 7*).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. **Claims 2, 4-6 and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shi (U.S. PG- Pub. No. 2002/0102977) in view of Tryding (U.S. Pat. No. 5,880,732).

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Regarding **claim 2** and as applied to claim 1, Shi discloses the aforementioned apparatus. Shi fails to disclose wherein said accessory comprises a videophone unit.

However in the same field of endeavor, Tryding discloses wherein said accessory comprises an external display monitor attached to the mobile telephone via a communication link conducting videophone functionalities (*col. 2, lines 39-51*).

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to have Shi cellphone apparatus to comprise a videophone unit device as taught by Tryding. For the purpose of, such feature would allow videoconferencing capabilities and enhance personal/interactive communication.

Regarding **claims 4, 5, 6**, and as each applied respectively to claims 1, 2, and 3, Shi discloses the aforementioned apparatus comprising a sub-communication means. Shi fails to disclose wherein said sub-communication means is infrared communication.

However in the same field of endeavor, Tryding discloses a sub-communications means wherein that communications link comprises an infrared communication link between a mobile telephone and another remote user (*col. 2, lines 51-57*).

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to have Shi cellphone apparatus to comprise a

sub-communication means such as infrared as taught by Tryding. For the purpose of effective and inexpensive short-range wireless communications.

Regarding **claim 8**, and as applied to claim 2, Shi in view of Tryding disclose the aforementioned apparatus comprising a sub-communication means. In addition Shi disclose, wherein said sub-communication means is radio communications (A radio communication such as a radio link between the mobile unit and the base station; *Page 1, Paragraph 12*).

8. **Claims 10, 12, 16, and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shi (U.S. PG- Pub. No. 2002/0102977) in view of Labeledz et al. (U.S. Pat. No. 6,308,072).

Regarding **claim 10**, Shi discloses a cellular telephone apparatus which has a cellular telephone set capable of originating a plurality of calls to a base station and communicating with an accessory (An accessory such as a base station) through sub-communication means (A mobile such as a cellular telephone apparatus having a cellular telephone set that has two or more links with different base stations involved in a handoff process, wherein one of the links is an alternative link such as a sub-communication means; *Page 1, Paragraph 7*), and said accessory capable of communicating with said cellular telephone set through said sub-communication means (A communication such as a physical connection/channel set between a mobile and a base station; *Page 1, Paragraph 5; Page 2, Paragraph 17*), and can execute a communication function other than a voice communication function by said cellular telephone set through said sub-



communication means (An apparatus adapted to a PCS communications system that bundle voice communications, numeric and text messaging, voice-mail and various other features into one device, and are carried over cellular links; *Page 2, Paragraph 16*), said cellular telephone set comprising: cellular telephone transceiver means for originating a plurality of calls to a base station (A mobile unit/cellphone that can transmit or receive in a plurality of calls to a base station; *Page 3, Paragraph 36*); sub-communication means for performing communication with said accessory (A communication such as a physical connection/channel set between a mobile and a base station; *Page 1, Paragraph 5; Page 2, Paragraph 17*); channel monitoring means for monitoring channel quality of said sub-communication means (Monitoring such as evaluating the signal quality for the communication between a mobile and an base station/accessory; *Page 2, Paragraph 17*); and control means for, when the channel quality of said sub-communication means has deteriorated to not more than a predetermined level, causing said cellular telephone transceiver means to start originating a call for voice communication with a remote cellular telephone set (A dynamic threshold corresponding to the signal quality from the present communication and handing off the communication to another base station wherein said base station establishes a coverage area/cell and the mobile unit starts to originates a call to the remote cellular telephone set through the handed base station; *Page 2, Paragraph 18; Page 4, Paragraph 43*), and said accessory comprises: sub-communication means for performing communication with said cellular telephone set (An accessory/base station that serves a mobile unit through a communication

means wherein that communication means is radio link; *Page 1, Paragraph 4 and Paragraph 12*). Shi fails to disclose wherein said accessory comprises expression means for expressing a content transferred by said sub-communication means; channel monitoring means for monitoring channel quality of said sub-communication means, and control means for when the channel quality of said-communication means has deteriorated to not more than a predetermined level, notifying said cellular telephone set of the corresponding information.

However in the same field of endeavor, Labedz et al. disclose an accessory/base comprising expression means for expressing a content transferred by said sub-communication means (message content transmitted from an accessory/base station to a mobile unit by a communication link; *col. 3, lines 40-43*), channel monitoring means for monitoring channel quality of said sub-communication means (Signal strength measurements taken at the base station while monitoring the location of a mobile unit; *col. 22, line 67 – col. 23, line 3*), and control means for, when the channel quality of said sub-communication means has deteriorated to not more than a predetermined level, notifying said cellular telephone set of the corresponding information (A base-station that transmits a message to the mobile station to force the mobile station into a soft handoff before interference occurs; *col. 3, lines 44-47*).

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to have Shi cellphone/apparatus comprising an accessory/base station and communicating with said accessory through sub-communication means to have expression, monitoring and control means within

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the accessory as taught by Labedz et al. For the purpose of, providing a bi-directional performance, as well as enhancing the sub-communication means between the cellphone and the accessory.

Regarding **claim 12**, and as applied to claim 10, Shi in view of Labedz et al. disclose the aforementioned apparatus comprising an accessory. In addition Shi discloses, wherein said accessory comprises a musical unit (A mobile unit or cellphone apparatus that can process sound data such as voice that could be applied for musical means; *Page 1, Paragraph 13*).

Regarding **claim 16**, and as applied to claim 10, Shi in view of Labedz et al. disclose the aforementioned apparatus, wherein said apparatus communicates to an accessory through sub-communication means. In addition Shi discloses, wherein sub-communication means is radio communication (A radio communication such as a radio link between the mobile unit and the base station; *Page 1, Paragraph 12*).

Regarding **claim 18**, and as applied to claim 12, Shi in view of Labedz et al. discloses the aforementioned apparatus, wherein said apparatus communicates to an accessory through sub-communication means. In addition Shi discloses, wherein said sub-communication means is radio communication (A radio communication such as a radio link between the mobile unit and the base station; *Page 1, Paragraph 12*).

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9. **Claims 11, 13-15, and 17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shi (U.S. PG- Pub. No. 2002/0102977) in view of Labedz et al. (U.S. Pat. No. 6,308,072), further in view of Tryding (U.S. Pat. No. 5,880,732).

Regarding **claim 11**, and as applied to claim 10, Shi in view of Labedz et al. disclose the aforementioned apparatus comprising an accessory. Shi in view of Labedz et al. fail disclose wherein said accessory comprises a videophone unit.

However in the same field of endeavor, Tryding discloses wherein said accessory comprises an external display monitor attached to the mobile telephone via a communication link conducting videophone functionalities (*col. 2, lines 39-51*).

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to have Shi in view of Labedz et al. cellphone apparatus to comprise a videophone unit device as taught by Tryding. For the purpose of, such feature would allow videoconferencing capabilities and enhance personal/interactive communication).

Regarding **claims 13, 14, and 15**, and as each respectively applied to claim 10, 11, and 12, Shi in view of Labedz et al. disclose the aforementioned apparatus. Shi in view of Labedz et al. fail to disclose wherein said sub-communication means is infrared communication.

However in the same field of endeavor, Tryding discloses a sub-communications means wherein that communications link comprises an infrared

communication link between a mobile telephone and another remote user (*col. 2, lines 51-57*).

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to have Shi in view of Labeledz et al. cellphone/apparatus to comprise a sub-communication means such as infrared as taught by Tryding. For the purpose of effective and inexpensive short-range wireless communications.

Regarding **claim 17**, and as applied to claim 11, Shi in view of Labeledz et al., further in view of Tryding disclose the aforementioned apparatus comprising a sub-communication means. In addition Shi disclose, wherein said sub-communication means is radio communications (A radio communication such as a radio link between the mobile unit and the base station; *Page 1, Paragraph 12*).

### ***Response to Arguments***

10. Applicant's arguments filed on April 5<sup>th</sup>, 2004 have been fully considered but they are not persuasive.

In response to Applicant's arguments against 35 U.S.C. § 102(e) rejection of independent **claims 1 and 19**, and the 35 U.S.C. § 103(a) rejection of independent **claim 10**, that "Shi is only capable of switching channels in the same phone call when there is a stronger signal obtainable by the cellular telephone. The present invention, as recited in independent claims 1, 10 and 19, provides for originating a call to keep the voice communication, which is different than the call

used by the cellular phone to perform videophone and/or other communication, when the signal has deteriorated or is of a low quality”.

The Examiner respectfully disagrees with the Applicant's argument because Shi clearly discloses an apparatus that can execute a communication function other than a voice communication function (An apparatus adapted to a PCS communications system that bundle voice communications, numeric and text messaging, voice-mail and various other features into one device, and are carried over cellular links; *Page 2, Paragraph 18*); control means for, when said monitoring means determines that the channel quality of the sub-communication has deteriorated to not more than a predetermined level, causing said cellular telephone set to start originating a call to the remote cellular telephone set (A dynamic threshold corresponding to the signal quality from the present communication and handing off the communication to another base station wherein said base station establishes a coverage area/cell and the mobile unit starts to originates a call to the remote cellular telephone set through the handed base station; *Page 2, Paragraph 18; Page 4, Paragraph 43*).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a control section originating a “phone call” or “different phone call” (originating a call, *See claim 1, line 19; claim 10, line 6, and claim 19, line 12*), keeping voice communication, which is different than the call used by the cellular phone to perform videophone and/or other communication) are not recited in the rejected claims *1, 10, and 19*. Although the claims are interpreted in light of the

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specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to Applicants' arguments against **claims 2-9, and 11-18**, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Therefore **claims 2-9, and 11-18** are still rejected because they depend on and include all the limitations of base **claims 1, 10, and 19**.

### ***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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12. Any response to this Office Action should be **faxed to** (703) 872-9306 or **mailed to:**

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**Hand-delivered** responses should be brought to

Crystal Park II

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Arlington, VA 22202

Sixth Floor (Receptionist)

13. Any inquiry concerning this communication on earlier communications from the Examiner should be directed to Ismael Quiñones whose telephone number is (703) 305-8997. The Examiner can normally be reached on Monday-Friday from 8:00am to 5:00pm.

14. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Marsha D. Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9301.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose number is (703) 305-4700 or call customer service at (703) 306-0377.



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*Ismael Quiñones*

I.Q

June 9, 2004

  
**CHARLES APPIAH**  
**PRIMARY EXAMINER**